

**REMARKS**

This Application has been carefully reviewed in light of the Final Office Action mailed January 12, 2005, and the Advisory Action dated March 18, 2005. At the time of the Final Office Action, Claims 1-20 were pending in this Application, and Claims 1-20 were rejected. At the time of the Advisory Action Claims 1-19 were pending in this Application. Applicant respectfully requests reconsideration and favorable action in this case.

**Rejections under 35 U.S.C. §103**

Claims 1-20 stand rejected under 35 U.S.C. §103(a) as being unpatentable over U.S. Patent Application Publication No. US 2002/0000215 filed by Jeff Powell (“Powell”) in view of U.S. Patent 2,372,485 issued to A.M. Griffin (“Griffin”) or U.S. Patent 2,586,528 issued to B.S. Gerson (“Gerson”). Applicant respectfully traverses and submits Claims 1-20 are patentable over Powell in view of Griffin or Gerson.

In order to establish a *prima facie* case of obviousness, the references cited by the Examiner must disclose all claimed limitations. *In re Royka*, 490 F.2d 981, 180 U.S.P.Q. 580 (C.C.P.A. 1974). Furthermore, according to § 2143 of the Manual of Patent Examining Procedure, to establish a *prima facie* case of obviousness, three basic criteria must be met. First, there must be some suggestion or motivation, either in the references themselves or in the knowledge generally available to one of ordinary skill in the art, to modify the reference or to combine reference teachings. Second, there must be a reasonable expectation of success. Finally, the prior art reference (or references when combined) must teach or suggest all the claim limitations. The teaching or suggestion to make the claimed combination and the reasonable expectation of success must both be found in the prior art, not in applicant’s disclosure. *In re Vaeck*, 947 F.2d 488, 20 U.S.P.Q.2d 1438 (Fed. Cir. 1991).

Here, the combination of the cited references does not teach and/or suggest all the limitations of the claimed embodiment of the invention and the art cited is not combinable. Powell teaches a “compression limiter” having “feet 24” which “bear the bolt load of a fastener which attaches a plastic manifold to a component.” [Col. 1, ¶ 0008] Thus, feet 24 are integral to the functioning of Powell’s described invention. (See Powell’s claims, all

including "plurality of protrusions (i.e., "feet").") Thus, according to Powell (assigned to a subsidiary of the present Assignee), to attach a plastic part to a metal part, one should utilize "feet 24" to bear the load.

Gerson, on the other hand, is directed to a metal bushing for reinforcing openings in the walls of metal die-castings. Thus, Gerson, it is maintained, is not directed to the problem solved by the present invention. Plastic components are not mentioned and/or relevant to Griffin's alleged invention.

Likewise, it is respectfully maintained that Griffin is not directed to the problem solved by the present invention but, is directed to purely metal systems. Thus, Applicant submits one of ordinary skill in the art would not look to Gerson and Griffin for help, especially with the teachings of Powell known. Withdrawal of the rejection is requested.

And, even if one was to combine the references, the combination would not yield the invention now claimed. For example, taking the Examiner's position, one would modify Powell with the teachings of Griffin or Gerson which would result in the claimed embodiment of the invention. The present claims are all directed to a "metallic insert," that is, a metal piece to be completely inserted into a fixing hole, i.e., it is an "insert". First, while it is unclear from Griffin and Gerson, apparently (according to the rejection) the two teach that Powell's feet or "protrusions" should be removed. However, this is an improper rejection because the modification seeks to change the principle of operation of Powell. The "feet" in Powell "bear" the load and thus, are essential. And MPEP § 2145.01 provides: "If the proposed modification or combination of the prior art would change the principle of operation of the prior art invention being modified, then the teachings of the references are not sufficient to render the claims *prima facie* obvious. *In re Rothi*, 270 F.2d 810 (CCPA 1959)." As stated above, the modification of Powell to remove Powell's feet to make Powell's "limiter" an "insert" is improper under MPEP 2143.01. Withdrawal of the rejection is requested.

In addition, the combination of Griffin does not, even assuming that feet of Powell are removed, yield a fixing hole with a protrusion and a metal insert with an indentation to receive the protrusion, but just the opposite.

## CONCLUSION

Applicant has now made an earnest effort to place this case in condition for allowance in light of the amendments and remarks set forth above. Applicant respectfully requests reconsideration of Claims 1-19, as amended.

Applicant encloses a check in the amount of \$790.00 for the Request for Continued Examination fee required by 37 C.F.R. 1.17(e). Applicant believes there are no additional fees due at this time, however, the Commissioner is hereby authorized to charge any fees to Deposit Account No. 50-2148 of Baker Botts L.L.P. in order to effectuate this filing.

If there are any matters concerning this Application that may be cleared up in a telephone conversation, please contact Applicant's attorney at 512.322.2606.

Respectfully submitted,

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